

make clear that the DNA need not be present in a totally "isolated" form to fall within the scope of the invention, but can exist in other environments such as the claimed vectors and cells. The added claims are believed to be in compliance with both 35 U.S.C. 101 and 35 U.S.C. 112.

Applicants respectfully traverse the obviousness-type double patenting rejection of claims 30-35 based on later-filed, copending Ser. No. 08/945,821.

The Examiner has pointed to the fact that SEQ ID NO:4 is disclosed in both this application and the later-filed '821 application.

In connection with obviousness-type double patenting, it is the claims which are relevant, not the disclosures. The Federal Circuit points out that the first step in carrying out an obviousness-type double patenting analysis is to construe the claims of the earlier patent [or here, application] and the later patent, and then, to determine whether the later claim encompasses subject matter previously claimed. *Eli Lilly and Co. v. Barr Laboratories, Inc.*, No. 99-1262 (*Fed. Cir.* 2000), citing *Georgia Pacific Corp. v. U.S. Gypsum Co.*, 52 U.S.P.Q. 2d 1590 (*Fed. Cir.* 1999).

The claims of the later-filed '821 application are drawn to chimeric genes, wherein two coding sequences are present which confer tolerance to a herbicide, and wherein one of the genes encodes an HPPD enzyme. The other coding sequence may encode an EPSPS, as recited in certain of the pending dependent claims of the '821 application.

Thus, the later-filed claims of the '821 application are not in a genus/species relationship with the claims involved here. Rather, they are drawn to a totally different, and patentably distinct invention, namely, the use of two different herbicide tolerance-producing genes forming part of the same chimeric gene construct. That invention is patentably distinct from the mutated EPSPS gene claimed here. Since the inventions claimed in the two applications are patentably distinct, there is no obviousness-type double patenting.

As to the possibility of adding claims drawn to mutated EPSPS in the copending '821 application, Applicants note that no such claim is pending now, nor is a claim to mutated EPSPS contemplated in that application. Such a claim, if made, would be an embodiment of the two-

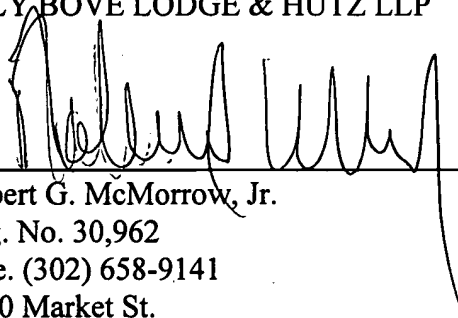
coding sequence chimeric gene construct being claimed in that application, and would still be patentably distinct from what is being claimed here.

Based on the foregoing, reconsideration of the rejections and favorable action on claims 36-41 is requested.

Respectfully submitted,

CONNOLLY BOVE LODGE & HUTZ LLP

By



Robert G. McMorrow, Jr.
Reg. No. 30,962
Tele. (302) 658-9141
1220 Market St.
Wilmington, DE 19899

Encl: Abstract of the Disclosure

::ODMA\MHODMA\CB;121771;1